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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,597	06/11/2002	Dieter Lehmann	15039	8378

7590 05/24/2004
Leopold Presser
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Carden City, NY 11530

EXAMINER

WOODWARD, ANA LUCRECIA

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 05/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/018,597	LEHMANN ET AL.	
	Examiner	Art Unit	
	Ana L. Woodward	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on February 27, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 1-11/17s are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group III in Paper filed February 27, 2004 is acknowledged. The traversal is on the ground(s) that the Examiner has failed to demonstrate that the claims are independent and distinct inventions and that examining all claimed inventions would constitute a serious burden. This is not found persuasive because the record shows that the inventions are distinct, each from the other. It is maintained that groups II and III are related as mutually exclusive species in an intermediate-final product relationship because the intermediate product of group II can be used in and of itself without the presence of the additional materials of group III, which materials would react in-situ to produce a mutually exclusive final product. Should applicants submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case, then groups II and III would be rejoined. It is also maintained that groups I and II are unrelated because group I is directed to the condensation of polyamides while group II is directed to a compatibilized blend. In any event, applicants should note that the search fields for the various groups are not co-extensive and that examination of all claimed inventions would indeed constitute a burdensome search. In fact, group III, in and of itself, already constitutes a burdensome search due to the plurality of different species encompassed by the claimed additive.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-11 and 17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected group, there being no allowable generic or linking

claim. Applicant timely traversed the restriction (election) requirement in Paper February 27, 2004.

Claim Rejections - 35 USC § 112

3. Claims 12-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 12, the format of the Markush group recitation "selected from" defining the linking group genus is improper.

Claim 14 is indefinite as to scope and meaning. It is unclear how the additional oligo- or polycarbonate block is linked to the structural element (I). How does said additional block differ from the CE₁ and CE₂ carbonate units?

Claim Rejections - 35 USC § 102/103

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 12-16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. 5,760, 143 (Kubo et al).

Kubo et al disclose an ester-amide block copolymer of formula (I) prepared by condensing an acyl-terminated aromatic diamide of formula (2) with a diol compound . In example 3, an ester-amide block copolymer, prepared by condensing an acyl-terminated aromatic diamide with a polycarbonate diol, is demonstrated.

The block copolymer of example 3 meets the requirements of the presently claimed additive of formula (I) as defined when P represents a polyamide block, CE₁ and CE₂ represent the same carbonate units and L represents a linking -COO-, -CO-, or -O- group. The onus is shifted to Applicants to establish that the block copolymer of the present claims is not the same as the product of the reference.

Claim 14 has been incorporated into this rejection because as previously noted, it is not seen that the additional polycarbonate block distinguishes over the carbonate units already present in the block copolymer.

Product-by-process claim 16 has been incorporated into this rejection because it is not seen that the product obtained by reacting a polycarbonate with a COOH-terminated polyamide would differ in structure from that disclosed by the reference.

7. Claims 12-16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 1-252640.

JP '640 discloses an aromatic polyamide-polycarbonate block copolymer prepared by reacting a polycarbonate compound with polyamide-forming monomers.

The block copolymer of the reference meets the requirements of the presently claimed additive of formula (I) as defined when P represents a polyamide block, CE₁ and CE₂ represent the same carbonate units and L represents a linking -COO-, -CO-, or -O- group. The onus is

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shifted to Applicants to establish that the block copolymer of the present claims is not the same as the product of the reference.

Claim 14 has been incorporated into this rejection because as previously noted, it is not seen that the additional polycarbonate block distinguishes over the carbonate units already present in the block copolymer.

Product-by-process claim 16 has been incorporated into this rejection because it is not seen that the product obtained by reacting a polycarbonate with a COOH-terminated polyamide would differ in structure from that disclosed by the reference.

Response to Amendment

8. Applicant's amendments filed February 27, 2004 have effectively overcome the rejection over EP 0415069.

Prior Art

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

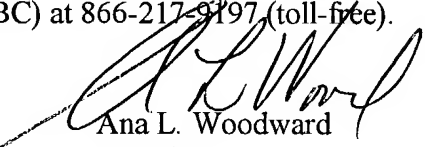
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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ana L. Woodward whose telephone number is (571) 272-1082. The examiner can normally be reached on Monday-Friday (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Ana L. Woodward
Examiner
Art Unit 1711

AW